

Application No. 09/766,004  
Reply to Office Action of January 27, 2006

### **REMARKS**

Presently, claims 1-38 are pending in the application. The Examiner has stated that claims 15 and 36 recite allowable subject matter, but are objected to as being dependent upon a rejected base claim.

#### ***Entry of Rule 116 Response***

Entry of the present response is respectfully requested because such response renders moot the outstanding rejections under 35 U.S.C. § 103(a). The response does not raise any new issues that would require further consideration and/or search, since all of the limitations in the pending claims were previously presented, considered and presumably searched. No new matter is raised by this response. **The response could not have been presented earlier since it responds to a new ground of rejection made in the Final rejection.**

#### ***Claim Rejection – § 103(a)***

The Examiner has rejected claims 1-2, 9, 11, 16-21, 23, 29, 31-33 and 38 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,463,585 B1 to Hendricks *et al.* ("Hendricks") in view of International Patent Application Publication No. WO 00/33233 to Eldering *et al.* ("Eldering"). The Examiner contends that Hendricks in view of Eldering renders the claimed invention obvious. Applicant respectfully traverses this rejection.

Hendricks teaches a system for providing television programming and targeted advertisements to consumers' homes. In Hendricks, information is sent from a program controller at an "operations center" to local storage or real-time display at a consumer terminal. The stored information may include control information, programming and/or advertisements. The operations center receives television programs and advertisements from external sources, and then packages those programs into groups according to categories that provide desired marketing of programming to subscribers. Hendricks teaches that information related to users' preferences, viewing actions or habits may be gathered, observed, retrieved and analyzed, such that a particular consumer terminal may be assigned to a desired target category. In Hendricks, this is accomplished by retrieving

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viewer data from set top terminals and transmitting the data to the headend for analysis and/or presentation (see column 20, lines 4-15 of Hendricks). The target category, based for example on demographic information about one or more individual viewers, is utilized to determine which advertisements to target at a consumer or group(s) of consumers. Hendricks teaches that there are several different methods of conveying the desired advertisements to the audience, including transmitting advertisements to the consumer via feeder channels and utilizing a switching plan to determine which feeder channel to switch to when a designated program break occurs.

Independent claim 1 recites:

A system for delivering targeted advertisements to subscribers in a television service network environment, the system comprising:

an ad scheduler for providing an ad schedule for a plurality of subscriber groups wherein each group is characterized by a market segment and a probabilistic measure of expected viewership, wherein the characterization is obtained through measurement of subscriber interactions with the television service network environment; and

a multiple presentation stream (MPS) generator for generating a plurality of presentation stream groups each corresponding to a particular programming channel, each of the presentation stream groups composed of a plurality of multiple presentation streams that are carrying the same programming and the same avails, each of the presentation streams carrying advertisements directed to different advertiser-specific market segments according to the ad schedule.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references, when combined) must teach or suggest all of the claim limitations. See MPEP 2143.

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Applicant respectfully submits that the combination of Hendricks and Eldering does not teach or suggest all of the elements of claim 1 as contended by the Examiner. Hendricks discloses that the operations center may send different groups of programs to different cable headends and/or set top terminals. The Examiner contends that because these groups are sent to a plurality of headends, this means that the groups of programs sent by the operations center are composed of a plurality of multiple presentation streams. The Examiner then contends that since groups sent to a plurality of headends are packaged by the operations center "into groups and categories which provide the optimal marketing of the programs to subscribers" and since the spot placement engine places default targeted ads in program breaks according to what is "most appropriate to the overall audience," that this teaches that each multiple presentation stream has ads directed to "different advertiser-specific market segments according to the ad schedule." Applicant respectfully disagrees with the Examiner's reading of Hendricks for the reasons discussed below.

There are at least two differences between Hendricks' teachings and claim 1. First, in Hendricks, each of the groups of programs sent to a plurality of headends has a default advertisement(s) associated with that individual group, targeted according to the most appropriate overall audience. That is, each group of programs that is packaged by the operations center includes a default ad which is selected, for example, according to the types of programs in that group. Therefore, a group of programs that is sent to one particular headend contains the same ads as the same group of programs that is sent to other, different headends, since each group contains the "default targeted advertisement." In contrast, claim 1 recites that within each presentation stream group, there are multiple presentation streams, "each of the presentation streams carrying advertisements directed to different advertiser-specific market segments according to the ad schedule."

Second, each group of programs sent by the operations center in Hendricks contains an ad that is targeted according to the most appropriate overall audience. Claim 1, however, recites that ads are targeted according to the "ad schedule." Targeting ads according to the most appropriate overall audience is not the same as directing ads according to an ad schedule. Therefore Hendricks does not teach this aspect of claim 1. Furthermore, the Examiner had previously concluded that the "ad schedule" of claim 1

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was equivalent to the "switching plan" taught by Hendricks (see page 2 of the Office Action, wherein the Examiner states "an ad schedule (switching plan ...)"). Although, Applicant does not necessarily agree or disagree with the Examiner's conclusion, the "switching plan" in Hendricks relates to the feeder channels taught by Hendricks and not the "default targeted advertisement." The advertisements provided by the feeder channels are not, and cannot be considered part of, the "presentation streams," and are thus not carried with those presentation streams. Instead, the feeder channels (i.e., the advertisements) are tuned to by the set top terminal during a corresponding programming break (see column 28, line 9-14 of Hendricks). The ads of the feeder channel do not become part of the program group that is transmitted to the set top terminal; instead the set top terminal tunes to the feeder channel and then tunes back to the programming group at the designated time. Such tuning or switching cannot be equated with "generating a plurality of presentation stream groups each corresponding to a particular programming channel, each of the presentation stream groups composed of a plurality of multiple presentation streams that are carrying the same programming and the same avails, each of the presentation streams carrying advertisements directed to different advertiser-specific market segments according to the ad schedule" as recited in claim 1. Therefore, the "default targeted advertisement," is not targeted according to the ad schedule (or even the switching plan), nor are the feeder channel ads included in the presentation streams. Therefore, Hendricks does not teach or suggest that advertisements in each of the presentation streams are directed "according to the ad schedule."

Eldering also does not teach or suggest the elements of claim one as recited above. Therefore, Applicant respectfully submits that for the preceding reasons Hendricks in view of Eldering does not teach or suggest all features of independent claim 1. Therefore, the Examiner has not satisfied the burden of *prima facie* obviousness with respect to the suggested combination of Hendricks and Eldering.

Similar to claim 1, independent claim 21, recites that "each of the presentation streams carrying advertisements directed to different advertiser-specific market segments according to the ad schedule." For the reasons stated above in relation to claim 1, Hendricks in view of Eldering does not teach or suggest all features of independent claim

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21. Therefore, claim 21 is patentable over the suggested combination of Hendricks and Eldering.

Dependent claims 2, 9, 11, 16-20, 23, 29, 31-33 and 38 are allowable at least by their dependency on independent claims 1 and 21, respectively. Reconsideration and withdrawal of the Examiner's § 103(a) rejection of claims 2, 9, 11, 16-20, 23, 29, 31-33 and 38 are respectfully requested.

The Examiner has rejected claims 3-8 and 22-29 as being unpatentable over Hendricks in view of Eldering and further in view of U.S. Patent 6,181,334 to Freeman *et al.* ("Freeman"). For the same reasons discussed above with respect to the Examiner's obviousness rejection over Hendricks and Eldering, independent claims 1 and 21 are believed to be allowable over the combination of Hendricks and Eldering. Applicant respectfully submits that Freeman does not teach or suggest any of the elements missing from this combination. Thus, independent claims 1 and 21 are believed to be allowable over the combination of Hendricks, Eldering, and Freeman.

Dependent claims 3-8 and 22-29 are allowable at least by their dependency on independent claims 1 and 21, respectively. Reconsideration and withdrawal of the Examiner's rejection of claims 3-8 and 22-29 are respectfully requested.

The Examiner has rejected claim 10 as being unpatentable over Hendricks in view of Eldering and further in view of U.S. Patent 6,493,875 to Eames *et al.* ("Eames"). For the same reasons discussed above with respect to the Examiner's obviousness rejection over Hendricks and Eldering, independent claims 1 and 21 are believed to be allowable over the combination of Hendricks and Eldering. Applicant respectfully submits that Eames does not teach or suggest any of the elements missing from this combination. Thus, independent claims 1 and 21 are believed to be allowable over the combination of Hendricks, Eldering, and Eames. Dependent claim 10 is allowable at least by its dependency on independent claim 1. Reconsideration and withdrawal of the Examiner's rejection of claim 10 is respectfully requested.

The Examiner has rejected claim 30 as being unpatentable over Hendricks in view of Eldering and further in view of Freeman and in further view of Eames. For the same reasons discussed above with respect to the Examiner's obviousness rejection over

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Hendricks and Eldering, independent claims 1 and 21 are believed to be allowable over the combination of Hendricks and Eldering. Applicant respectfully submits that neither Freeman nor Eames teaches or suggest any of the elements missing from this combination. Thus, independent claims 1 and 21 are believed to be allowable over the combination of Hendricks, Eldering, Freeman, and Eames. Dependent claim 30 is allowable at least by its dependency on independent claim 21. Reconsideration and withdrawal of the Examiner's rejection of claim 30 is respectfully requested.

### *Claim Objection*

The Examiner has objected to claims 15 and 36 as being dependent upon a rejected base claim, but stated that these claims would be allowable if rewritten in independent form to include all limitations of the base claim and any intervening claims. For the reasons set forth above, Applicant respectfully submits that independent claims 1 and 21 are allowable. Therefore, claims 15 and 36 are allowable at least by their dependency on independent claims 1 and 21, respectively. Reconsideration and withdrawal of the Examiner's objection to claims 15 and 36 are respectfully requested.

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### Conclusion

In view of the foregoing remarks, Applicant respectfully submits that the Examiner's rejections and objections have been overcome, and that the application, including claims 1-38, is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections and objections and an early Notice of Allowance are respectfully requested.

Respectfully submitted,

Date: 5/24/06

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